

Remarks

1. Status of the Claims

Presently pending are claims 1-33, of which claims 1, 27, 30, and 32 are independent and the remainder are dependent.

2. Summary of the Office Action

In the office action mailed September 19, 2008, the Examiner rejected claims 1-7, 13, 14, 16, 17, 19-21, 30, 32 and 33 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,714,791 (Friedman). Further, the Examiner rejected claims 8, 10-12, and 15 under 35 U.S.C. § 103(a) as being allegedly obvious over Friedman in view of U.S. Patent No. 6,477,387 (Jackson), the Examiner rejected claims 18 and 22 under 35 U.S.C. § 103(a) as being allegedly obvious over Friedman in view of U.S. Patent No. 6,504,503 (Saint-Hilaire), the Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being allegedly obvious over Friedman in view of U.S. Patent No. 6,119,014 (Alperovich), and the Examiner rejected claim 27 under 35 U.S.C. § 103(a) as being allegedly obvious over Friedman in view of U.S. Patent No. 6,668,173 (Greene).

In addition, the Examiner objected to claims 9, 24-26, 28, 29 and 31 but indicated they would be allowable if rewritten in independent form.

3. Response to Rejections

a. Claims 1-7, 13, 14, 16, 17, 19-21, 30, 32 and 33

The Examiner rejected claims 1-7, 13, 14, 16, 17, 19-21, 30, 32, and 33 under 35 U.S.C. § 102(e) as being allegedly anticipated by Friedman. Of claims 1-7, 13, 14, 16, 17, 19-21, 30, 32, and 33, claims 1, 30, and 32 are independent. Claim 1 recites a location-reporting method

involving determining whether a first mobile subscriber is located in a common zone with a second mobile subscriber. Claim 30 recites a similar method and claim 32 recites a system similar to the method of claim 1.

As Applicants discussed in their Response to the Office Action mailed March 6, 2008, Friedman does not teach a location-reporting method involving a first mobile subscriber being located in the same zone as a second mobile subscriber, nor does Friedman teach making a determination whether the second mobile subscriber is located in a zone in common with the first mobile subscriber.

In the Final Office Action mailed September 18, 2008, the Examiner stated that “making a determination that a second mobile subscriber is located in a zone in common with a first mobile subscriber” of claim 1 was anticipated by Friedman’s “reads on within a certain proximity to User A.” The Examiner cited to Applicants’ Specification as stating “the zone can be defined with respect to the requesting subscriber, such as **an area** covering a predefined distance from the subscriber.” (Office Action, p. 2). The Examiner’s reliance on this statement shows a misunderstanding between the concept of two users in the same zone and a user within a distance from another user. The statement the Examiner referenced in the Specification defines a zone as a designated area. An area is not the same as a distance between two entities. Being “within a certain proximity,” that is, a certain distance away from user A, is not the same as being within the same zone as user A. These are two different concepts.

Friedman teaches the concept of sending an alert if a user is within a specified distance from another user. For example, “Jackie indicates that users Dave and Andy should generate an alert if they are within 0.2 miles of her; Joe within 5 miles; and Matt within 1 mile.” (Col. 13,

lns. 64-66). Thus, Friedman teaches generating alerts when a user B is within a specified distance range from user A. The notification when a user is within a specified distance range is a different concept from determining whether user B is in a zone in common with user A. A zone is a designated location or area. (Specification, p. 3 lns. 16-17). User B may be located within a certain distance from user A yet not be located in the same location or area as user A. The distance between users does not tell whether both users are located in a common zone.

Applicants submit that Friedman does not teach the concept of both users being located in a zone in common. Because Friedman does not teach this concept, Friedman does not anticipate claims 1, 30, and 32. Applicants thus submit that claims 1, 30, and 32 are allowable. Furthermore, Applicants submit that dependent claims 2-7, 13, 14, 16, 17, 19-21, and 33 are allowable for at least the reason that they depend from allowable claims 1, 30, and 32.

b. Claims 8, 10-12, and 15

The Examiner rejected claims 8, 10-12, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Friedman, in view of Jackson. Claims 8, 10-12, and 15 depend from claim 1. For the reasons discussed above, claim 1 is allowable over Friedman. Applicants submit that dependent claims 8, 10-12, and 15 are allowable for at least the reason that they each depend from allowable independent claim 1. Jackson does not make up for the deficiency of Friedman, as Jackson also does not describe functions using a “common zone.”

Because the limited teachings of Friedman and Jackson would not have reasonably led a person of ordinary skill in the art to achieve the claimed invention, a *prima facie* case of obviousness of claims 8, 10-12, and 15 over Friedman and Jackson does not exist.

c. Claims 18-22

The Examiner rejected claims 18-22 under 35 U.S.C. § 103(a) as being unpatentable over Friedman, in view of Saint-Hilaire. Claims 18-22 depend from claim 1. For the reasons discussed above, claim 1 is allowable over Friedman. Saint-Hilaire does not overcome the deficiency of Friedman as Saint-Hilaire does not teach the concept of considering whether two users are located in a common zone.

Because the limited teachings of Friedman and Saint-Hilaire would not have reasonably led a person of ordinary skill in the art to achieve the claimed invention, a *prima facie* case of obviousness of claims 18-22 over Friedman and Jackson does not exist.

Without conceding the Examiner's assertions with respect to the dependent claims, Applicants submit that dependent claims 18-22 are allowable for at least the reason that they depend from allowable claim 1.

d. Claim 23

The Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Friedman in view of Alperovich. Claim 23 depends from claim 1. As previously argued, claim 1 is allowable over Friedman. Applicants submit that dependent claim 23 is allowable for at least the reason that it depends from allowable independent claim 1. The reference cited by the Examiner, Alperovich, does not overcome the deficiency of Friedman as Alperovich does not teach the concept of considering whether two users are located in a common zone.

Because the limited teachings of Friedman and Alperovich would not have reasonably led a person of ordinary skill in the art to achieve the claimed invention, a *prima facie* case of obviousness of claim 23 over Friedman and Jackson does not exist.

Without conceding the Examiner's assertions with respect to the dependent claim, Applicants submit that dependent claim 23 is allowable for at least the reason that it depends from allowable claim 1.

e. Claim 27

The Examiner rejected independent claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Friedman in view of Greene. In rejecting this claim, the Examiner relied on the same teachings of Friedman that the Examiner cited in the rejection of claim 1, and the Examiner asserted that what Friedman lacked was determining that reporting the first mobile subscriber's location to the second mobile subscriber is blocked. However, Friedman is more deficient than that. At a minimum, for the reasons discussed with regard to claim 1 above, Friedman fails to teach "reporting the first mobile subscriber's location to the second mobile subscriber provided that the second mobile subscriber is located in a zone in common with the first mobile subscriber."

According to M.P.E.P. §§ 2142 and 2143, the Examiner must establish a *prima facie* case of obviousness by clearly articulating reasons with rational factual underpinnings to support the conclusion of obviousness. In this case, Applicant respectfully submits the *prima facie* case has not been established. The limited teachings of Friedman and Greene would not have led a person of ordinary skill in the art to achieve the claimed invention as set forth in claim 27.

Given that the Examiner apparently relied on Friedman for allegedly teaching the element of "reporting the first mobile subscriber's location to the second mobile subscriber provided that the second mobile subscriber is located in a zone in common with the first mobile subscriber," and given that Friedman does not teach that element, the Examiner's rejection of

claim 27 does not have the factual underpinnings required by law to establish *prima facie* obviousness. Greene does not make up for the deficiencies of Friedman, as Greene also does not describe functions using a “common zone.”

Because the limited teachings of Friedman and Jackson would not have reasonably led a person of ordinary skill in the art to achieve the claimed invention, a *prima facie* case of obviousness of claim 27 over Friedman and Greene does not exist.

Because a *prima facie* case of obviousness over Friedman and Greene does not exist, Applicants submit that claim 27 is allowable.

4. Allowable Claims

As noted above, the Examiner objected to claims 9, 24-26, 28, 29 and 31 as being dependent upon a rejected base claim but stated that these claims would be allowable if rewritten in independent form. Applicants submit that dependent claims 9, 24-26, 28, 29 and 31 are allowable for at least the reason that they depend from allowable independent claims 1, 27, and 30. Therefore, Applicants submit that the claims should be allowed in their current form without the need to be rewritten in independent form.

5. Conclusion

For these reasons, Applicants respectfully request favorable reconsideration and allowance of all of the pending claims.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-3347.

Respectfully submitted,

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